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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,666	11/29/2001	Vincent Morin	P 283192 RP-00204-US2	2647
909	7590	06/07/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			ILAN, RUTH	
			ART UNIT	PAPER NUMBER
			3616	
DATE MAILED: 06/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/995,666

Applicant(s)

MORIN, VINCENT

Examiner

Ruth Ilan

Art Unit

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- PT 104  
6/10/01 4) ☒ Claim(s) 32  
~~33-51~~ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6/10/01 6) ☒ Claim(s) 32  
~~33-51~~ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. The amendment of March 11, 2004 is acknowledged. An action on the merits follows below.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rigid hoses and calipers mounted to the frames must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

3. Claim 39 is objected to because of the following informalities: "rer" should be "rear". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 39-44, and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the rear disk brake disposed on the rear differential. Based on the specification and the drawings as filed, the rear disk brake is disposed on the rear drive shaft.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 39 and 45 recite the limitation "the rear differential" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (US 6,491,126) in view of Youmans (US 4,081,049) or Schmid (US 3,439,786) Robinson et al. teaches an ATV including four low pressure balloon tires (20,22), a handlebar operatively connected to steer the ATV (inherently) and a saddle (see Figure 1.) Also taught is an engine and transmission (see col. 9, lines 44-51.) Regarding the rear brake disk, it is the Examiner's position that Robinson et al. teaches a rear brake disk (243, see Figure 10) that is, as broadly claimed "associated" with the rear drive shaft, because "associated" is a very broad term, and the broadest

reasonable interpretation encompasses the interconnected relationship disclosed in Figures 9 and 10. Regarding the front brakes, as shown in Figure 4, Robinson et al. further teaches a front differential (123) and first and second half shafts with first, second, third and fourth joints (111, 114, 121, and 118, see col. 10, line 39- col. 11, line 15.) Robinson et al. further teaches a pair of brake disks (129) and additionally teaches connection via a flanged coupling (131) but fails to teach that the disks are connected to the joints that are the first and third joints, that is those proximate the differential. Youmans teaches that it is desirable to mount the brake disks to the joints located proximate the differential because the braking efficiency is improved (see col. 5, lines 4-15.) Schmid teaches that it is desirable to mount disk brakes to inboard joints to minimize the unsprung weight of the vehicle (see Schmid col. 1, lines 34-59 and Figure 2b.) It would have been obvious to one having ordinary skill in the art at the time of the invention to mount the disk brakes of Robinson et al. to the first and third joints, in order to maximize brake efficiency as taught by Youmans, or to minimize the unsprung weight of the vehicle, as taught by Schmid. Regarding claims 33-36, Robinson et al. fails to specifically disclose a caliper associated with the disk brake. Applicant admits that such calipers are known and further that such calipers can be either mechanically or hydraulically actuated (see paragraph [0003] of the instant application. Both Schmid and Youmans teach that it is known to include calipers (Schmid, elements 3,4 and Youmans (21c and 21d.) Regarding claims 37, and 38, Youmans shows a direct attachment to the frame and Schmid shows a direct attachment to the differential. It would have been obvious to one having ordinary skill in the art at the time of the invention to include

Art Unit: 3616

calipers using either mechanical or hydraulic actuation, with the disk brakes of Robinson et al., in order to provide for braking engagement with the disks, as taught by both Youmans or Schmid, and as admitted by the Applicant. Regarding claim 35, Schmid includes a rigid hydraulic hose. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a rigid hose as a normal engineering expedient, as taught by Schmid, in order to have the most rugged parts possible.

11. As best understood, claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (US 6,491,126) in view of Youmans (US 4,081,049) or Schmid (US 3,439,786) and further in view of Takimoto (US 4,667,760.) Robinson et al. in view of Schmid or Youmans is discussed above, and fails to teach a rear disk brake mounted on the rear differential. Takimoto teaches that it is desirable to mount her rear brake on the rear differential gear box, and mount the disk on the drive shaft (see figure 13) because this is a protected area, which is easily accessible both of which are useful when considering ruggedness requirements for ATVs (see col. 1, especially lines 55-57.) It would have been obvious to one having ordinary skill in the art to move the mounting of the rear disk brake of Robinson et al. in view of Youmans or Schmid to the rear drive shaft/differential as taught by Takimoto, in order to provide a protected location for the disk brake. Regarding claims 40, 41, 43, 46, 47, and 49, Takimoto teaches various embodiments of hydraulically or mechanically actuated calipers. Regarding claims 42 and 48, Schmid includes a rigid hydraulic hose. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a

rigid hose as a normal engineering expedient, as taught by Schmid, in order to have the most rugged parts possible. Regarding claims 44 and 50, Youmans shows a direct attachment to the frame for the calipers.

***Response to Arguments***

12. Applicant's arguments filed March 11, 2004 have been fully considered but they are not persuasive. It is the Examiner's position that "associated" is a very broad term, and Robinson et al. does show a disk brake associated with the rear drive shaft.

13. Applicant mentions that Robinson et al. is assigned to the present assignee. If the Applicant intends to disqualify Robinson et al. as available prior art under 35 USC 103(c), the applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the

reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

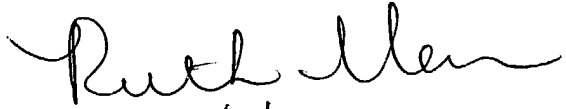
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth Ilan whose telephone number is 703-306-5956. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

Art Unit: 3616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 703-308-2089. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth Ilan  
Primary Examiner  
Art Unit 3616

  
6/1/04

RI  
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